REMARKS/ARGUMENTS

Claim 6 is currently pending and is being amended with this response.

I. *Examiner Interview Summary*

The Applicant expresses his appreciation for the June 15, 2006 Examiner interview. In the interview, claim 6 was discussed along with the *Huffman* reference. No allowable subject matter was agreed upon.

II. *Rejection of Claim 6 under 35 U.S.C. § 103(a)*

The rejection of Claim 6 under 35 U.S.C. § 103(a) as being allegedly unpatentable by U.S. Patent No. 5,215,307 (the "*Huffman* reference") is respectfully traversed.

A prima facie case of obviousness is established when one or more references that were available to the inventor and teach that a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Under M.P.E.P. § 706.02(j), three basic criteria must be met for the *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references

when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, prior art may be considered not to teach an invention and thereby may fail to support an obviousness rejection, particularly when the stated objectives of the prior art reinforce such an interpretation. *WMS Gaming Inc., v. International Game Tech.*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999).

The *Huffman* reference teaches a training exercise method. The method provides a normal balance to the user while the user swings a counter weighted device. (*See*: Abstract)(Emphasis added). The device taught by the Huffman reference includes a shaft with weights at opposing ends that counter balance each other. In the background section, the *Huffman* reference discloses that a training device having a weight at only one end of a training device results in the disadvantage of pulling the user toward the weight. (*See*: Col. 1, lines 10-11). Applicant specifically notes that the *Huffman* reference requires opposing and counter balancing weights. In fact, the *Huffman* reference repeatedly emphasizes the objectives of counter balancing weights. (*See*: Col. 1, lines, 28, 38, 50; and Col. 2, lines 7, 12, 26 and 55).

The *Huffman* reference discloses that a need exists for an exercise method that does not affect the balance of the user while performing the exercise. (*See*: Col.1, lines 20-21). Specifically, the *Huffman* reference states that counter balancing of the weights is critical to maintain balance. (*See*: Col. 1, lines 38-39). Furthermore, the *Huffman* reference states that the "key is the counter balanced weights at opposite ends of the shaft with one of the weights being between the hands on the grip and the user's body." (*See*: Col. 2, lines 54-57)(Emphasis added).

In contrast, claim 6 of the present application recites that the device consists essentially of a weight positioned at the second end of the handle while the first end remains weight free. A claim that depends from a claim that "consists of" the recited elements or steps cannot add an element or step. When the phrase "consists of" appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole. M.P.E.P. § 2111.03 Transitional Phrases, (*citing*: *Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 793 F.2d 1279 (Fed. Cir. 1986). *See* also *In re Crish*, 393 F.3d 1253 (Fed. Cir. 2004)).

The present application teaches that the positioning of the second end weight and the positioning of its center of mass direct the effect of the weight in a concentrated manner to the forearms of the user, as recited in amended claim 6. (*See*: Specification

page 1, line 22, page 2, lines 8-9 and page 10, lines 22-26). In other words, the weighted second end weight and the free weighted first end of the present application results in an unbalanced force that directs the concentration of the effect of the weight to the user's forearm. Furthermore, in order to concentrate the effect of the weight to the user's forearm, the weight must be at the second end of the handle. As such, the weight of the present application is not positioned between the user's hand and the user's body as taught and emphasized by the *Huffman* reference.

Since the present application discloses the weight at the second end of the handle and discloses the first end of the handle as weight free to provide an unbalanced weight, one skilled in the art would not be motivated to seek out the *Huffman* reference due to the required balanced weights and the stated objectives of the *Huffman* reference. As decided by the Federal Circuit, a prior art reference was interpreted not to teach the claimed invention while using the stated objectives described in the prior art to reinforce the interpretation. *WMS Gaming Inc., v. International Game Tech.*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The Examiner notes that the opposing weights as taught by the *Huffman* reference do not have to be the same weight. The Examiner, however, then concludes that such difference in weight measurements "clearly" leads to a configuration as having no weight on one of the ends of the device. As previously, noted, the *Huffman* reference repeatedly emphasizes the objectives of

counter balancing weights. Further, the *Huffman* reference specifically teaches that the individual weights will vary between two and six pounds. (*See*: Col. 1, lines 50-51). As such, the *Huffman* reference does not clearly serve as a free weighted end as contended by the Examiner. Furthermore, the specific teaching of counter balanced weights leads to a center of mass between the opposing weights. Accordingly, the *Huffman* reference does not teach a suggestion or motivation to modify in order to achieve the present application. As such, a prima facie case of obviousness has not been achieved.

Additionally, the *Huffman* reference does not teach or suggest all of the present claim limitations such as the first end of the handle being weight free and the positioning of the center of mass being within the weight. These claimed features of the present application direct the effect of the weight in a concentrated manner to the forearms of the user.

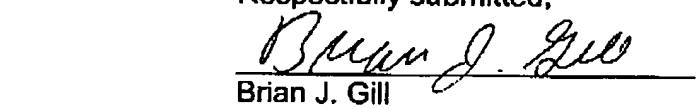
The analysis by the Examiner has not provided a prima facie case of obviousness. The Applicant respectfully requests the Examiner to comment on the Applicant's DVD presentation that was provided in the previous response. As noted in the DVD illustrating a prototype video relating to the application, the experts repeatedly assert that speed and power come from the forearms (*See also*: video presentation which highlights forearm strength exercises). Furthermore, as shown in the video

presentation, the claimed feature of the single weight positioned at the second end allows the user to swing the device near the body of the user.

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office action, and as such, the present applicant is in condition for allowance.

Entrance of the amendment and passage of the case to issue are therefore respectfully requested. If the Examiner believes that personal communication will expedite prosecution of the application, the Examiner is invited to telephone the undersigned at (314) 238-2400.

Respectfully submitted,



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